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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Appln. of: Amad Tayebi

Serial No.: 09/253,174

This is a Continuation Application of Serial No. 08/828,878 filed on March 31, 1997 which issued as U.S. Patent No. 5,989,667 on November 23, 1999.

Filed: February 19, 1999

For: A Postable Sticker

Group: 1772

Examiner: Ahmad, Nasser

Attn: Patent Appeals
Board of Patent Appeals and Interferences
The Commissioner of Patents and Trademarks
Washington, DC 20231

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APPELLANT'S BRIEF ON APPEAL

Dear Sir:

This brief is being filed in support of Appellant's Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences. The notice of Appeal was timely filed on July 25, 2002.

1. STATEMENT OF REAL PARTY IN INTEREST

This application has not been assigned to any entity and applicant is the sole owner and is the sole real party in interest. In this appeal, applicant is represented by himself.

2. RELATED APPEALS AND INTERFERENCES

None

3. STATUS OF THE CLAIMS ON APPEAL

12/31/2002 BABRAHA1 00000043 09253174

01 FC:2402 160.00 OP

12/31/2002 BABRAHA1 00000043 09253174

02 FC:2253 460.00 OP

All of the currently pending claims (i.e., claims 13, 15 and 19) have been finally rejected and are on appeal. The claims on appeal are set forth in Appendix A.

4. STATUS OF AMENDMENTS

No Amendments have been made after the Final Office Action of March 25, 2002. All claims, as presented in Appendix A, were amended prior to the Final Office Action dated March 25, 2002.

5. SUMMARY OF THE INVENTION

The present invention is in the field of temporarily postable stickers such as those marketed by Minnesota Mining and Manufacturing Company under the tradename Post-It. Its pending three claims identify three needs, which have not been identified nor addressed in the prior art, and meet them with solutions that are simple, effective and structurally distinguishable from the prior art.

The postable stickers of the prior art comprise two areas; a first area which is coated on its underside with a non-destructive repositionable adhesive, and a second area which is not coated with any adhesive.

A first need that the present invention meets, in claim 13, is to enable the user of the sticker to separate the first area from the second area by tearing the sticker along an intentionally and structurally built-in weakened tear line which separates the first area from the second area, thus enabling the user to save the second area, with whatever information written on it, without encountering the inconvenience of stickiness of the first area.

A second need that the present invention meets, in claim 15, is to enable the user of the sticker to remove a portion of the second area by tearing the second area along an

intentionally and structurally built-in weakened tear line which is located, in its entirety, within the second area. This structural feature extends the utility of the postable sticker to provide a non-sticking portion for other uses while preserving the first area and at least a portion of the second area; i.e., preserving a smaller but complete postable sticker.

A third need that the present invention meets, in claim 19, is to enable the user to subdivide a postable sticker into at least two postable stickers by tearing the postable sticker along an intentionally and structurally built-in weakened tear line which originates from the edge of the first area and ends at the edge of the second area. By enabling the user to subdivide the postable sticker into smaller postable stickers, this structural feature makes it possible for the user to purchase fewer sizes of postable stickers and selectively divide each sheet into posting flags and/or smaller postable stickers.

6. ISSUES PRESENTED ON APPEAL

The following three issues are presented on appeal:

1. Whether claim 13 (thrice amended) is unpatentable under 35 U.S.C. 102 (b) and under 35 U.S.C. 103 (a) over Madole; U.S. Patent No. 5, 299,833.
2. Whether claim 15 (thrice amended) is unpatentable under 35 U.S.C. 102 (b) and under 35 U.S.C. 103 (a) over Madole; U.S. Patent No. 5, 299,833.
3. Whether claim 19 is unpatentable under 35 U.S.C. 102 (b) and under 35 U.S.C. 103 (a) over Madole; U.S. Patent No. 5, 299,833.

7. GROUPING OF THE CLAIMS ON APPEAL

Claim 13 (thrice amended) stands on its own,
Claim 15 (thrjce amended) stands on its own, and
Claim 19 stands on its own.

8. ARGUMENT

The arguments presented below provide an analysis of the Examiner's rejections set forth in a final office action dated March 25, 2002, in which reference is made to a previous office action (dated August 6, 2001, paper no. 18). The prior art cited by the Examiner has been carefully analyzed with regard to its scope and specific reasons as to why the Examiner's rejections under 35 U.S.C. 102 (b) and under 35 U.S.C. 103 (a) are improper.

The Examiner rejected claims 13, 15 and 19 "under 35 U.S.C. 102(b) as being anticipated by Madole [U.S.Patant No. 5,299,833] for reasons of record in paper no. 18, paragraph-6, mailed on August 6, 2001." In paper no. 18, paragraph-6, mailed on August 6, 2001, Examiner stated:

"Madole relates to a paper sheet having a first area provided with strip of repositionable pressure sensitive adhesive (PSA) and second area that is substantially free from adhesive as shown in figures 1-4. The adhesive strip covers the first area at least partially. As shown in figure-1, after the web is cut into discrete sheet along line 14, the sheet is also provided with weakened tear line 16 or 18 for separating the first area from the second area (figs. 2-4). Further, in col. 4, line 30-39, Madole teaches that the adhesive can be coated along its entire back surface or at least so much such that the pad can be secured to a supporting surface".

The Examiner also rejected claims 13, 15 and 19 "under 35 U.S.C. 103(a) for obviousness over Madole [U.S.Patant No. 5,299,833] for reasons of record in paper no. 18, paragraph-8, mailed on August 6, 2001." In paper no. 18, paragraph-8, mailed on August 6, 2001, Examiner stated:

"Madole, as discussed above, fails to teach that the adhesive coated at least so much as to provide securement comprise "complete and continuous" covering. It would have been an obvious matter of design choice to modify Madole by providing

a continuous and complete covering of adhesive in the first area to provide for optimum adhesive securement based on optimization through routine experimentation".

Applicant respectfully disagrees with the Examiner's analysis of Madole's structure.

Anticipation requires that each and every element in the applicant's claim be present in the cited prior art. Obviousness requires the presence of a teaching or a suggestion to modify the prior art in order to obtain the structure of the claimed invention. Neither of these requirements are met in the Examiner's rejection.

In order to distinguish Applicant's invention, claimed in claims 13, 15 and 19, applicant would first like to invite the attention of the Board of Patent Appeals and Interferences to what Madole's structure comprises. Madole teaches a pad comprising a plurality of discrete paper sheets secured to one another along registering margins and overlying one another, "a first separation line extending generally parallel to and inwardly of the registering margins of said sheets, a second separation line extending generally parallel to said first separation line and spaced inwardly therefrom; and repositional adhesive disposed on a face portion of each sheet between said separation lines. . ." (Source: Madole '833, claim 1). Madole's structure is shown clearly in Figures 2, 3 and 4 and is obtained, as taught in Madole and as shown in Figure 1 of Madole by advancing a s web W of paper "in a machine direction indicated by the arrow. As illustrated, web W has a plurality of successive panels 10 and 12 in side-by-side relation one to the other and connected to one another along a longitudinal centerline 14 and along which centerline 14 the discrete sheets 10 and 12 are cut and collated to form a pad of sheets S. The individual panels 10 and 12 are likewise cut or burst transversely along cut lines or lines of perforation 16 and 18 to separate the sheets S longitudinally one from the other in the direction of web travel" (Source; Madole '833, Column 2, line 62 to Column 3, line 3).

Madole's structure, shown in Figure 2 is described in detail as "sheet S contains on its back or rear face a strip of repositionable adhesive 20 and 22 inset from the longitudinal cut line 14 and extending between the opposite longitudinally spaced margins of sheets S. In terms of the pad or chart comprising the individual sheets S when assembled, the strips of adhesive extend transversely on the rear face of each sheet from opposite lateral margins of the pad and are inset from the top of the pad to define an uncoated strip 24 between the top margin of the pad and the strip of adhesive on the pad... (Source: Madole '833, column 3, line 4 to line 13).

Clearly, Madole's structure is distinguishable from applicant's in that it does not comprise a first area which extends to the top edge of the sheet and which is completely and continuously coated with a non-destructive adhesive as specified in applicant's claims 13 and 15. Rather, Madole's structure specifies an adhesive-free registering margin area at the top of sheet S by applying the adhesive only between a first separation line, which extends parallel to and inwardly of the registering margin and a second separation line which is spaced inwardly from the first separation line. Further Madole does not suggest a corresponding modification of its sheet to yield applicant's sticker claimed in claims 13 and 15.

In addition, Madole' structure is distinguishable from applicant's in that it does not comprise a weakened tear line that extends from the top edge of the sheet to the bottom edge of the sheet as specified in applicant's claim 19. Further Madole does not suggest a corresponding modification of its sheet to yield applicant's sticker claimed in claim 19.

From the above analysis it is evident that claims 13, 15 and 19 are patentable over Madole both under 35 U.S.C. 102 (b) and 103 (a).

CONCLUSION

Thus, for the foregoing reasons, it is respectfully submitted that the Examiner's rejection of the application is in error, and should be reversed.

Respectfully Submitted



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APPENDIX (A)

Claims on Appeal

Claim 13 (thrice-amended):

A temporary posting [pressure sensitive] adhesive-coated [postable] sticker[, said postable sticker being] capable of being temporarily attached to an application surface, comprising:

a sheet of opaque flexible material, said sheet having a perimeter defined by two parallel side edges, a top edge and a bottom edge, said sheet having at least one first area and at least one second area; said first area extending [being located immediately adjacent] to said top edge of said perimeter and extending from one of said parallel side edges to the other of said parallel side edges and being completely and continuously [at least partially] coated with a pressure sensitive adhesive coating; said second area being located immediately adjacent to said first area and being substantially free from said adhesive coating and providing a memo writing space; said adhesive coating being of a temporary adhesion nature such that when said sticker is attached to and subsequently peeled off said application surface, said pressure sensitive adhesive coating remains on said first area of said sticker and said application surface suffers no damage; and,

at least one weakened tear line, selected from the group consisting of pre-slit cut lines, perforated lines and microperforated lines, wherein said weakened tear line being of such a shape and location that it substantially separates said at least one first area from said at least one second area and wherein said weakened tear line providing a low tear strength that directs an initial tear, started at one of the parallel side edges of said perimeter, to propagate along its path by offering lower resistance to tear against an applied tear force[; and]

[said temporary posting pressure sensitive adhesive-coated postable sticker being directly stacked, in perfect perimeter registration, onto a plurality of identical stickers, directly stacked in perfect perimeter registration upon one another, without having any protecting means, release liners or spacers between said postable sticker and said plurality of identical stickers nor between the successive layers of said plurality of identical stickers.]

Claim 15 (thrice-amended):

A temporary posting [pressure sensitive]adhesive-coated [postable]sticker[, said postable sticker being] capable of being temporarily attached to an application surface, comprising:

a sheet of opaque flexible material, said sheet having a perimeter defined by two parallel side edges, a top edge and a bottom edge, said sheet having at least one first area and at least one second area; said first area extending [being located immediately adjacent] to said top edge of said perimeter and extending from one of said parallel side edges to the other of said parallel side edges and being completely and continuously [at least partially] coated with a pressure sensitive adhesive coating; said second area being located immediately adjacent to said first area and being substantially free from said adhesive coating and providing a memo writing space; said adhesive coating being of a temporary adhesion nature such that when said sticker is attached to and subsequently peeled off said application surface, said pressure sensitive adhesive coating remains on said first area of said sticker and said application surface suffers no damage; and,

at least one weakened tear line, selected from the group consisting of pre-slit cut lines, perforated lines and microperforated lines, wherein said weakened tear line extends from one of said parallel side edges to the other of said parallel side edges and is located, in its entirety, within said at least one second area and wherein said weakened tear line providing a low tear strength that directs an initial tear, started at either end of said weakened tear line, to propagate along the path of said weakened tear line by offering lower resistance to tear against an applied tear force[; and]

[said temporary posting pressure sensitive adhesive-coated postable sticker being directly stacked, in perfect perimeter registration, onto a plurality of identical stickers, directly stacked in perfect perimeter registration upon one another, without having any protecting means, release liners or spacers between said postable sticker and said plurality of identical stickers nor between the successive layers of said plurality of identical stickers.]

Claim 16 (new):

A temporary posting adhesive-coated sticker capable of being temporarily attached to an application surface, comprising:

a sheet of opaque flexible material, said sheet having a perimeter defined by two parallel side edges, a top edge and a bottom edge, said sheet having at least one first area and at least one second area; said

first area extending to said top edge of said sheet perimeter and extending from one of said parallel side edges to the other of said parallel side edges and being at least partially coated with an adhesive coating; said second area being located immediately adjacent to said first area and being substantially free from said adhesive coating and providing a memo writing space; said adhesive coating being of a temporary adhesion nature such that when said sticker is attached to and subsequently peeled off said application surface, said adhesive coating remains on said first area of said sticker and said application surface suffers no damage; and,

at least one weakened tear line, selected from the group consisting of pre-slit cut lines, perforated lines and microperforated lines, wherein said weakened tear line extends from said top edge to said bottom edge and wherein said weakened tear line providing a low tear strength that directs an initial tear, started at either end of said weakened tear line, to propagate along the path of said weakened tear line by offering lower resistance to tear against an applied tear force.